

Pre-filing Issues and Preparation for IP-related Internet Cases

Presentation to the Litigation Committee of
the Intellectual Property Law Section of
the State Bar of California



Sean Morris
Arnold & Porter LLP
777 S. Figueroa Street, Ste. 4400
213.243.4222
Sean.Morris@aporter.com

Overview of Internet Pre-Filing Issues and Considerations

- Common Types of IP-Related Internet Claims
- What Type of Site/Activity Is Involved?
- Who Is Responsible For The Site / Content?
- Personal Jurisdiction?
- Pre-Filing Evidence Issues
- Statutes to Keep In Mind

Common Types of IP-Related Internet Claims

- Copyright
- Trademark / Unfair Competition
- Right of Publicity
- Trade Secret
- Counterfeiting

What Type of Site/Activity Is Involved?

- “Pure” Business Commerce Site
- Search Engine
- Individual Site
 - *E.g.*, “Fan” Site
- User Generated Content
 - Host/Operator of the Site
 - Users on/of the Site
- Affiliates / Traffic Drivers
 - Email Can Deliver Users Here

Who Is Responsible For The Site / Content?

- Sometimes obvious
- “Whols”-type search (for domains)
- Other “public sources”
 - Social Networking
 - Blogs
 - Chats
- Follow the money

Who Is Responsible For The Site / Content?, Cont.

- Pre-Naming Formal Discovery
 - Potential DMCA subpoena (Copyright)
 - Subpoena issued to ISP under DMCA provisions
 - But can be limited. *E.g., RIAA v. Verizon Internet Svs.*, 351 F.3d 1229 (C.A.D.C. 2003) (quashing subpoena where ISP was only a transitory network)
 - Doe Pleading, Expedited Discovery Under FRCP 26
 - *E.g., Arista Records v. John Does 1-19*, -- F. Supp. 2d --, 2008 WL 1851772 (D.D.C. April 2008) (where plaintiffs showed *prima facie* copyright infringement and good cause that third-party discovery was needed to identify defendants, early discovery permitted)

Personal Jurisdiction -- Website Issue

- “Interactive” v. “Passive”
 - “A passive website and domain name alone do not satisfy the . . . effects test” *Pebble Beach Co. v. Caddy*, 453 F.3d 1151, 1160 (9th Cir. 2006)
 - Anticipate post-filing jurisdictional battle and discovery

Pre-Filing Evidence Issues

- Get What's There Now
 - Printing
 - “Film” the Action
- Consider What Was There
 - Caching and Archive.org (Internet Archive)
 - *Healthcare Advocates v. Harding, Earley*, 497 F. Supp. 2d 627 (E.D. Pa. 2007) (discussing manner in which archive.org operates)
 - Admissible?
 - *Lorraine v. Markel Am. Ins.*, 241 F.R.D. 534, 553 (D.Md. 2007) (“Internet Archive is a relatively new source for archiving websites. Nevertheless, Plaintiff has presented no evidence that the Internet Archive is unreliable or biased.”)

Pre-Filing Evidence Issues, Cont.

- What are users of the site saying?
 - May reflect knowledge or obvious problems on the site

- What are others saying about the site?
 - Off-site blogs
 - Chats

Pre-Filing Evidence Issues, Cont.

- How will it ultimately be packaged to the Court?
 - Keep track of how material is collected
 - Be mindful of admissibility issues
 - Internet material gets voluminous very fast
 - Court/Judge technically savvy?
 - Rules on electronic submissions?

Some Statutes To Keep In Mind

Digital Millennium Copyright Act (“DMCA”) 17 U.S.C. § 512

- In copyright actions, establishes “safe harbors” for certain types of Internet activities that qualify.
 - Transitory network communications
 - System caching
 - Information at direction of users
 - Only if no actual knowledge of infringement, nor
 - Awareness of facts/circumstances from which activity is apparent
 - Information location tools
- What is the DMCA stated position and policy of the site at issue?

Some Statutes To Keep In Mind, Cont.

Communications Decency Act (“CDA”) 47 U.S.C. § 230

- “No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.”
- “The term ‘interactive computer service’ means any . . . provider that provides or enables computer access by multiple users to a computer server”

Some Statutes To Keep In Mind, Cont.

- **“Nothing in this section shall be construed to limit or expand any law pertaining to intellectual property.” Section 230(e)(2)**
 - “In the absence of a definition from Congress, we construe the term ‘intellectual property’ to mean ‘federal intellectual property.’” *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1119 (9th Cir. 2007) (concluding that defendants had immunity for all state-law claims).
 - “[I]n line with the First Circuit’s dictum in *Universal*, this court disagrees with the Ninth Circuit’s decision in *Perfect 10* that [Section] 230(e)(2) exempts only federal intellectual property laws from the operation of [Section] 230. Consistent with its text, § 230(e)(2) applies simply to ‘any law pertaining to intellectual property,’ not just federal law.” *Doe v. Friendfinder*, 540 F. Supp. 2d 288, 302 (D.N.H. 2008 (March))